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Appln. No. 09/622,656
Appeal Brief Dated August 31, 2005
In Support of Notice of Appeal filed July 7, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Takako Hirose, et al.
Appln. No. : 09/622,656
Filed : October 30, 2000
Title : SYSTEM FOR DELIVERING MESSAGE AND PROCESSING
THE MESSAGE ON SERVER BASED ON INSTRUCTION
FROM THE CLIENT AFTER THE MESSAGE DELIVERING
COMPLETED

Conf. No. : 2705
TC/A.U. : 2154
Examiner : Jinsong Hu

Customer No. : 000,116
Docket No. : 32911

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF

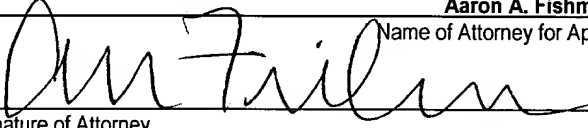
Sir:

This brief is filed in support of the Notice of Appeal mailed July 5, 2005, which was accorded a filing date of July 7, 2005. Therefore, the two-month period for filing this brief pursuant to 37 CFR § 41.37(a)(1) expires on September 7, 2005.

Pursuant to 37 CFR § 41.37(a)(2), this brief is accompanied by the requisite fee of \$500 under 37 CFR § 41.20(b)(2).

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32911.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

Aaron A. Fishman
Name of Attorney for Applicant(s)

Signature of Attorney
August 31, 2005
Date

37 CFR § 41.37(c)(1)(i) – REAL PARTY IN INTEREST

Matsushita Electric Industrial Co., Ltd., a company organized under the laws of Japan.

37 CFR § 41.37(c)(1)(ii) – RELATED APPEALS AND INTERFERENCES

None.

37 CFR § 41.37(c)(1)(iii) – STATUS OF CLAIMS

Claims 1-6 stand rejected by the Office Action of February 4, 2005 and are forthwith appealed to the Board of Patent Appeals and Interferences.

A clean copy of the claims presented for appeal are attached as the Appendix.

37 CFR § 41.37(c)(1)(iv) – STATUS OF AMENDMENTS

No amendments have been filed subsequent to final rejection.

37 CFR § 41.37(c)(1)(v) – SUMMARY OF CLAIMED SUBJECT MATTER

The present invention is an improved email delivery system in which a server notifies a client system of new messages and then the client requests delivery of the messages. The server unit includes a message start notification means for sending a notification to the client system in response to arrival of a succeeding message at the server. Therefore, according to the invention, it is not necessary for the client system to send a request to the server in order to determine if new messages have been received.

Specifically, with reference to FIGS. 1 and 2, claim1 requires a message delivery system having a client system (100) acquiring a delivery message from a server unit by requesting to transmit the delivery message stored in the server unit (200) in compliance with a notification from the server unit (200)(see page 6, lines 12-24).

The client system (100) includes a received message storing means (106) for storing delivery message information received from the server unit (200). The client system (100) also includes an instruction and message acquisition requesting means (102, 105) for informing the server unit of a succeeding message acquiring request (Step S32, FIG. 3), if a succeeding message is present and a process instructing request for the delivery message whose reception is completed when reception of the delivery message from the server unit is completed (Step S38, FIG. 3) (see page 7, line 2 to page 8, line 2; see also page 10, lines 23-25 and page 12, lines 2-6).

The server unit (200) includes a message start notification means (201) for sending said notification to the client system (100) in response to arrival of the succeeding message at the server (200) (see FIG. 5 and page 14, lines 21-23; see also page 8, line 20 to page 9, line 2). The server unit (200) also includes a delivery message storing means (205) for storing the delivery message to be transmitted to the client system (100) (see page 9, lines 2-4). The sever unit (200) further includes a message processing means (202, 203) for transmitting a succeeding message stored in the delivery message storing means (205) to the client system (100) in compliance with a request from the client system (100) (Steps S40 to S44, FIG. 4) and then processing the delivery message whose reception is completed (Step S46, FIG. 4)(see page 9, lines 5-16).

**37 CFR § 41.37(c)(1)(vi) – GROUND OF REJECTION TO BE
REVIEWED ON APPEAL**

Claims 1-6 were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 6,314,454 to Wang et al. (hereinafter “‘454”) in view of U.S. Patent No. 6,175,858 to Bulfer et al. (hereinafter “‘858”).

37 CFR § 41.37(c)(1)(vii) – ARGUMENT

The Law

The rejection under appeal in the present case is made under 35 U.S.C. 103(a). When combining or modifying references under 103(a), an Examiner must establish a *prima facie* case of obviousness or the rejection will be overturned. See *In re Rinehart*, 189 USPQ 143 (CCPA 1976); *In re Linter*, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 170 USPQ 88 (CCPA 1971), *amended*, 171 USPQ 294 (CCPA 1971); *In re Warner*, 154 USPQ 173 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). The seminal case of *Graham v. John Deere Co.*, 383 U.S. 1, illuminates three steps or factual inquiries that an Examiner must engage in to establish such a *prima facie* case of obviousness. According to *Graham*, the examiner must: (1) set forth each of the differences between the claim and the reference(s) sought to be combined or modified; (2) set forth the proposed modification; and (3) explain why the proposed modification is obvious. 383 U.S. at 17. The case of *In re Jones* further explained that the third step in *Graham* amounts to a showing of some suggestion or motivation in the prior art that would lead one of ordinary skill in the art to pursue the proposed modification. 21 USPQ.2d 1941, 1943 (Fed. Cir. 1992); see also *In re Vaeck*, 20 USPQ.2d 1438 (Fed. Cir. 1991). In the case of *In re Fritch*, the Court established that the prior art must have suggested the desirability of the modification. 23 USPQ.2d 1780 (Fed. Cir. 1992). Further, the required suggestion or

motivation in the prior art must be clear and particular. *In re Dembiscak*, 175 F.3d 994, 999 (CAFC 1999).

Having set forth the appropriate standard for establishing obviousness, the specific rejections are discussed hereinafter.

Application of the Law

Applicants submit that, even if the '454 patent and the '858 patent were combined as stated in the rejection, every limitation of claim 1 would not be taught or suggested, as required. Specifically, neither the '454 patent nor the '858 patent teaches or suggests "a message start notification means for *sending said notification to the client system in response to arrival of the succeeding message at the server*," as required. The Examiner acknowledges that the '454 patent does not teach or suggest these limitations, and therefore cites the '858 patent for this purpose.

Briefly, for reasons explained below, the teaching in the '858 of notifying a user about a new message is not the same sending a notification to the client system in response to the arrival of a message, as in claim 1.

The '858 patent teaches a system for retrieving messages from multiple email accounts and combining them into a single mailbox. The system includes an agent (12) that notifies a *user* of new messages using a predetermined notification method (column 2, lines 49-51). The '858 patent does not teach or suggest that the agent sends a notification to a *client system*, as in claim 1. In particular, the '858 patent teaches that the agent (12) notifies the user that a new message has been received by "paging the user or calling the user at a designated number," (column 2, lines 52-53). This in no way suggests communication between the agent (12) and the user's mail client system.

The user cannot be considered a client system for purposes of claim 1, since the claim requires that the client system includes means for requesting the messages from the server and acquiring and storing the requested messages. Further, even if the user's paging system or telephone system were considered a client system, for purposes of claim 1, the '858 patent does not teach or suggest a telephone or a pager having capabilities that would all of the limitations of the client system set forth in the claim.

The '858 patent also teaches, as an alternative to paging or calling the user, that after the new messages are retrieved and deleted from the user's mail server by the agent, the agent can then send a single message back to the user's mail server informing the user that new messages have been received by the agent. Again, this does not in any way suggest communication between the agent and a mail client system that can retrieve the messages.

Conclusion

For all of the above reasons, every limitation of the claims has not been taught or suggested by the '454 patent, the '858 patent, or any combination thereof.

In summary, the Examiner has improperly equated sending a non-interactive notification to a user with sending a notification to a client system that new messages have been received for the purpose of triggering the client system to automatically retrieve the new messages. Clearly, the rejection based upon this improper interpretation of the prior art is improper and must be reversed.

For the aforesaid reasons, it is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness in making each of the appealed rejections. Therefore, it is hereby requested that each of Examiner's rejections be reversed.

Respectfully submitted,

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Date: August 31, 2005

37 CFR § 41.37(c)(1)(viii) – CLAIMS APPENDIX

1 **Claim 1 (previously presented):** A message delivery
2 system having a client system acquiring a delivery message
3 from a server unit by requesting to transmit the delivery
4 message stored in the server unit in compliance with a
5 notification from the server unit,
6 wherein the client system includes a received message
7 storing means for storing delivery message information
8 received from the server unit, and an instruction and
9 message acquisition requesting means for informing the
10 server unit of a succeeding message acquiring request, if
11 a succeeding message is present, and a process instructing
12 request for the delivery message whose reception is
13 completed when reception of the delivery message from the
14 server unit is completed, and
15 wherein the server unit includes a message start
16 notification means for sending said notification to the
17 client system in response to arrival of the succeeding
18 message at the server, a delivery message storing means for
19 storing the delivery message to be transmitted to the
20 client system, and message processing means for
21 transmitting a succeeding message stored in the delivery
22 message storing means to the client system in compliance
23 with a request from the client system and then processing
24 the delivery message whose reception is completed.

1 **Claim 2 (original):** The message delivery system
2 according to claim 1,
3 wherein, by instructing to delete from the delivery
4 message storing means of the server unit as the process for
5 the delivery message whose reception is completed,
6 the message processing means deletes the delivery
7 message, which is informed by the client system and whose
8 reception is completed, from the delivery message storing
9 means in compliance with an instruction from the client
10 system.

1 **Claim 3 (original):** The message delivery system
2 according to claim 2,
3 wherein the server unit holds the delivery message
4 stored in the delivery message storing means until its
5 deletion is instructed by the client system, and then
6 transmits the same delivery message once again when it
7 receives an acquiring request from the client system.

1 **Claim 4 (original):** The message delivery system
2 according to claim 1,
3 wherein the server unit further includes a processed
4 message storing means for storing the messages delivered to
5 the client system, and

6 wherein, by instructing to move from the delivery
7 message storing means of the server unit as the process for
8 the delivery message whose reception is completed,
9 the message processing means moves the delivery
10 message, which is informed by the client system and whose
11 reception is completed, from the delivery message storing
12 means to the processed storing means in compliance with an
13 instruction from the client system.

1 **Claim 5 (original):** The message delivery system
2 according to claim 4,

3 wherein the server unit holds the delivery message
4 stored in the delivery system storing means until its
5 movement is instructed by the client system, and then
6 transmits the same delivery message once again when it
7 receives an acquiring request from the client system.

1 **Claim 6 (original):** A message delivery system
2 according to claim 1, further comprising:

3 a message instruction requesting means for informing
4 the server unit of only a process instruction request for
5 the delivery message whose reception is completed when
6 there is no succeeding message.